



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,491	03/10/2004	Ronald E. Dykes	312-101P-WLK	3036

7590 06/15/2007
LAW OFFICES OF WILLIAM L. KLIMA, P.C.
2046-C JEFFERSON DAVIS HIGHWAY
STAFFORD, VA 22554

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
----------	--------------

3731

MAIL DATE	DELIVERY MODE
-----------	---------------

06/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,491

Applicant(s)

DYKES, RONALD E.

Examiner

Michael Thaler

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 3731

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-17 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gerten (2004/0167540). Gerten discloses handle 11 and template portion 12 which is inherently capable of providing indentations on the corneal surface since the application of pressure on the corneal surface by the protrusions 14 will inherently indent it. Alternatively, it would have been obvious

Art Unit: 3731

that template portion 12 is capable of providing indentations on the corneal surface for this reason. As to claim 6, the central aperture of template portion 12 is a sight. As to claim 8, one of the protrusions 14, when considered separately, is a single protrusion. Note that applicant considers a protrusion 20 of the application to be a single protrusion even though there are other protrusions 20 and 18 on the instrument. As to claim 9, all of the protrusions 14 considered together define a plurality of protrusions. As to claim 13, protrusions 14 are located on a plurality of radii (i.e. one radius for each protrusion).

Claims 7 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerten (2004/0167540). As to claim 7, Gerten fails to disclose the specific shape of the sight. However, it is old and well known to so shape sights in order to obtain the advantage of precisely aligning two objects. It would have been obvious to so shape the Gerten sight so that it too would have this advantage. As to claims 18-20, Gerten fails to disclose the specific pattern of the protrusions. However, it is old and well known to so locate protrusions on corneal markers in order to obtain the advantage of precisely marking the cornea. It would have been obvious to so locate the Gerten protrusions so that it too would have this advantage.

Art Unit: 3731

Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Cote (6,171,324). Note col. 3, line 22 to col. 4, line 3 of Cote.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cote (6,171,324). The Cote specification fails to specification indicate that the marking is temporary. However, it would have been obvious that it is temporary since the pressure marks are obviously not made with sufficient pressure as to permanently damage the eye.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note [0070] of Peyman (2005/0090895).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571) 272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Application/Control Number: 10/796,491

Page 5

Art Unit: 3731

mht

A handwritten signature in black ink, appearing to read "Michael Thaler", written in a cursive style.

MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731